

DISCUSSION OF THE AMENDMENT

Due to the length of the specification herein, Applicants will cite to the paragraph number of the published patent application (PG Pub) of the present application, i.e., US 2004/0166084, when discussing the application description, both in this section and in the Remarks section, *infra*, rather than to page and line of the specification as filed.

Claim 1 has been amended by inserting that the surfactant component consists of the cationic surfactant and optionally, at least one of an amphoteric surfactant and a nonionic surfactant, as supported in the specification at paragraph [0048].

Claim 6 has been amended by limiting component (B) to the recited cationic surfactant and correcting a typographical error. Claim 7 has been amended by limiting component (B) to the recited tertiary amine type compound.

New Claims 11-13 have been added. Claim 11 is supported in the specification at paragraphs [0040], [0044] and [0046] combined. Claims 12 and 13 are supported in the specification at paragraph [0060].

No new matter is believed to have been added by the above amendment. Claims 1-13 are now pending in the application. Claim 7 stands withdrawn as directed to a non-elected species.

REMARKS

The rejection of Claims 1-6, 8 and 10 under 35 U.S.C. § 102(e) as anticipated by US 2005/0095217 (Hirano '217), is respectfully traversed. **Submitted herewith** is a certified English translation of Applicants' priority applications JP 2002/375321 and JP 2002/375322, both filed December 25, 2002. The earliest publication date of Hirano '217 is January 15, 2003. The Examiner is respectfully requested to find that Applicants are entitled to their priority date and thus, Hirano '217 is removed as prior art. Accordingly, it is respectfully requested that the rejection be withdrawn.

The rejection of Claims 1-5 and 8-10 under 35 U.S.C. § 103(a) as obvious over US 6,685,953 (Hoshino et al '953) or US 2003/0208858 (Hirano '858) or US 2003/0215416 (Hirano '416) or US 2003/0215410 (Hirano '410) or US 2005/0095212 (Hirano '212) or US 2004/0115162 (Hoshino et al '162) all taken alone and combined with US 5,977,038 (Birtwistle et al), is respectfully traversed.

As a preliminary matter, if the above-discussed certified English translations of the priority documents support the present claims, each of the above Hirano documents are removed as prior art. In addition, Hoshino et al '953 and Hoshino et al '162 are identical in subject matter, since Hoshino et al '162 issued from a divisional application of the application which issued as Hoshino et al '953. Thus, discussion below with regard to the Hoshino et al documents will be to Hoshino et al '953, referred to as Hoshino et al *per se*.

Hoshino et al is drawn to a dermatologic preparation described as capable of exerting excellent effects of maintaining normal barrier functions of the horny layer, restoring and reinforcing damaged barrier functions, heightening water retention of the horny layer and remedying skin chapping (column 1, lines 6-10), which preparation comprises a particular diamide derivative (column 2, line 1ff), and which preparation may contain surfactants such as nonionic surfactants, anionic surfactants, cationic surfactants and amphoteric surfactants

(column 7, lines 58-62). Cationic surfactants are specified when used as a cosmetic preparation for a hair rinse, conditioner, hair treatment or hair styling agent (column 8, lines 16-24). It is noted further that Hoshino et al discloses that when their dermatological preparation is intended for use as a shampoo, it may contain, as a main active agent, an anionic surfactant such as an alkyl ether sulfate, alkyl sulfate or olefin sulfonate (column 8, lines 10-13).

As recognized by the Examiner, Hoshino et al does not disclose the presence of a silicone. The Examiner thus relies on Birtwistle et al.

Birtwistle et al is drawn to an aqueous conditioning shampoo composition comprising at least one surfactant chosen from (i) anionic, nonionic, zwitterionic or amphoteric surfactants or mixtures thereof; (ii) emulsified particles of an insoluble, nonvolatile silicone; and (iii) a soluble cationic hair conditioning polymer having a cationic charge density of about 3.0 meq/g or less, and wherein the silicone particles have a particular particle size (Abstract).

While Applicants do not challenge the combination of Hoshino et al and Birtwistle et al in the formulation of a shampoo composition, wherein the surfactant is an anionic, nonionic, zwitterionic or amphoteric surfactant, or mixtures thereof, it is only with the present disclosure as a guide that one of ordinary skill in the art would combine a disclosure of a non-cationic surfactant-containing shampoo with a disclosure for a cationic surfactant-containing non-shampoo. Birtwistle et al discloses and suggests nothing with regard to what effect their silicone would have when combined with a cationic surfactant, i.e., a type of surfactant particularly omitted from their component (i). Indeed, one of ordinary skill in the art reading this prior art could not have predicted the results demonstrated in the specification herein when each of components (A), (B) and (C) are present and used in the present pH range. Examples 1-3 are according to the present invention. Comparative Examples 1-3 are not.

Comparative Example 1 lacks component (C); Comparative Example 2 lacks component (A); and Comparative Example 3 contains all three components but its pH is outside the range of the present claims. See the compositions and the results in Table 1 at paragraph [0088] of the specification. The Examples and Comparative Examples were evaluated for smoothness of hair, moist feeling of hair, prevention of split ends or breakage of hair and storage stability. The superior results obtained using the examples of the invention is manifest.

For all the above reasons, it is respectfully requested that this rejection be withdrawn.

The rejection of Claims 1-6 and 8-10 under 35 U.S.C. § 103(a) as unpatentable over EP 1,166,766 (EP Hoshino et al) and Birtwistle et al and US 5,034,218 (Duvel), is respectfully traversed. EP Hoshino et al is identical in subject matter to above-discussed Hoshino et al, since each claims priority to the same Japanese application filed April 8, 1999 (11-101076), and are thus from the same patent family. Duvel is drawn to a hair conditioning shampoo containing an anionic cleaning surfactant, a cationic di-long chain alkyl quaternary nitrogen-containing conditioning agent, a non-volatile silicone, and an anionic cross-linked polymeric suspending agent (Abstract). If the above prior art were combined, the result would necessarily include an anionic surfactant. However, the presently-claimed invention necessarily excludes the presence of an anionic surfactant. Nevertheless, the above combination of references could not have predicted the superior results obtained by the present invention, as discussed above.

For all the above reasons, it is respectfully requested that this rejection be withdrawn.

In view of the cited prior art, the Examiner is respectfully requested to withdraw the Election of Species requirement for component (A).

Applicants respectfully call the Examiner's attention to the Information Disclosure Statement (IDS) filed November 7, 2007. The Examiner is respectfully requested to initial

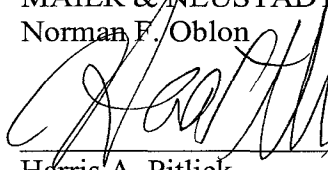
Application No. 10/743,834
Reply to Office Action of July 27, 2007

the Form PTO 1449 submitted therewith, and include a copy thereof with the next Office communication.

All of the presently pending and active claims in this application are now believed to be in immediate condition for allowance. The Examiner is now respectfully requested to extend the search to the subject matter of Claim 7, and in the absence of further grounds of rejection, pass this application to issue with all pending claims.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

A handwritten signature in black ink, appearing to read 'Harris A. Pitlick', is written over a horizontal line.

Harris A. Pitlick
Registration No. 38,779

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)

NFO:HAP\la